

D5561

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent Application of: Watkins et al. )  
Serial No.: 10/849,996 )  
Filed: May 20, 2004 )  
For: Core Element Fastening And Assembly Method )

**REQUEST FOR DECLARATION OF UNAVAILABILITY OF INVENTOR**  
**UNDER 37 C.F.R. 1.47 AND STATEMENT OF FACTS**

Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sirs:

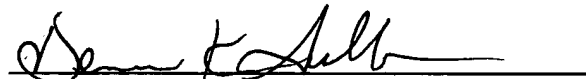
Pursuant to 37 C.F.R. 1.47, Applicant requests that Daniel Davis, a joint inventor of the above-identified application, be declared unavailable and that prosecution of this application be continued without his signed 37 C.F.R. 1.63 Declaration. Upon commencement of his employment as an independent contractor with Indianapolis Casting Corporation ("ICC"), a wholly-owned subsidiary of International Truck and Engine Corporation, Daniel Davis agreed in Section 4 of his Contracted Service Agreement that all intellectual property made or conceived during his contract is the property of ICC and agreed to assign to ICC the sole and exclusive right title and interest in and to inventions, discoveries and improvements. The above-identified application was made during such employment. Attached is a copy of the Contracted Service Agreement signed by Mr. Davis. (**Exhibit A**).

A copy of the above-mentioned application – including specification, claims, drawings, declaration and power of attorney, foreign assignments, assignment, and return envelope – was forwarded to Mr. Davis, one of the listed inventors, via Federal Express with delivery receipt requested on August 26, 2004, to his last known address at 1107 N. Mitthoffer Rd., Indianapolis, IN 46299 (**Exhibit B**). Applicant received a delivery receipt on August 27, 2004 stating it had been delivered (and signed for by "A. Watson") (**Exhibit C**), yet no signed documents were ever returned to Applicant from Mr. Davis. Repeated attempts were made to call Mr. Davis at his last known home phone number (317-985-0866), each attempt resulting in a recording that the number was not in service. (See also, Declaration of Catherine M. Majewski, attached as **Exhibit D**).

Applicant therefore attests that diligent effort was made to locate Mr. Davis and obtain his signature on the above-mentioned application.

Applicant therefore respectfully requests that the Commissioner declare Daniel Davis unavailable, or, in the alternative, has refused to sign the application, since the package was delivered, and allow continued prosecution of the above-mentioned application without his executed declaration under 35 U.S.C. 1.63. .

Respectfully submitted,

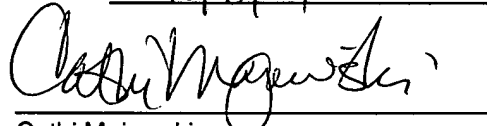


Dennis Kelly Sullivan  
Registration No. 26,510

Warrenville, IL 60555  
Date: November 8, 2004  
Telephone: (630) 753-2311

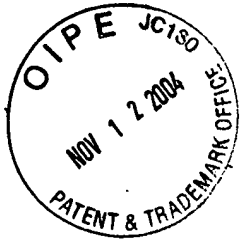
**CERTIFICATE OF FIRST CLASS MAILING UNDER 37 C.F.R. 1.8 (a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on or before 11/8/04.

  
Cathi Majewski

**Indianapolis Casting Corporation**5565 Brookville Road  
Indianapolis, IN 46219  
(317)352-4500

EXHIBIT "A"



#90322

**CONTRACTED SERVICE AGREEMENT**

THIS AGREEMENT is entered into this 27th day of October 2003, between ICC (hereafter called ICC and Dan Davis (thereafter called the "Contractor").

WHEREAS, ICC wishes the Contractor to furnish from time to time, and at ICC'S request, certain services which the contractor is qualified to perform; and WHEREAS, the Contractor is willing to render such services to ICC.

NOW THEREFORE, the parties hereto do hereby agree as follows:

1. ICC shall retain the Contractor to render, under ICC'S direction, the following services to the Corporation:

Mechanical Engineer

2. The Contractor agrees, as an independent contractor, to perform such services from November 1, 2003 to January 30, 2004.
3. In consideration of the Contractor rendering services to ICC, the Contractor shall be paid on the following basis:

Hourly rate of \$30.00 per hour. All Hours in excess of 40 will be paid at time and one-half rate.

4. The Contractor agrees to communicate to ICC all inventions, discoveries, computer programs, algorithms, technical data and information resulting from this project made or conceived by the Contractor on behalf of ICC solely or in collaboration with ICC personnel during the term of the agreement and they shall become and remain the property of ICC. At the request of ICC, the Contractor shall execute any and all documents deemed necessary to assign or to convey to it, its successors or assigns, the sole and exclusive right, title and interest in and to such inventions, discoveries and improvements to any Letters Patent therefore.

5. The Contractor agrees that all drawings, graphics, technical analyses, models, prototypes, writings, computer programs, algorithms, and other materials related to and emanating from work performed under this agreement, are considered to be works for hire and shall become and remain the property of ICC. At the request of ICC, the Contractor shall execute any and all documents which ICC may deem necessary to assign to it, its successors or assigns, the sole and exclusive right to such designs, models or other materials, as well as to design registrations, design patents and copyright relating thereto.
6. The Contractor agrees not to disclose to any third party or use, except in connection with specific ICC assignments, any confidential information relating to ICC processes, products, equipment, or trade secrets as well as confidential information resulting from this project. Any information not available to the public shall be considered confidential for the purpose of this agreement, but should any of this information be published or otherwise made available to the public by ICC or by third parties without breach of this agreement, the Contractor shall be free to use such publicly available information.
7. All materials, including without limitation, documents, drawings, models, sketches, designs, computer tapes and disks, and list furnished to the Contractor by ICC shall remain the property of ICC and shall be returned promptly upon completion of the assigned project or at time upon written request of ICC. The Contractor agrees not to make any copies of any such materials without ICC'S permission and to return any copies authorized with the original materials.
8. Circle the appropriate paragraph listed below (8a. or 8b.) and "x-out" the other.
  - 8a. In recognition of the special nature of the services to be rendered by the Contractor to ICC, the parties specifically agree that the Contractor will not be deemed an employee of ICC for any purposes other than those required by law. The Contractor hereby waives any and all claims he/she or any of his/her dependents, heirs, or legal representatives might otherwise have to receive any benefit under any of ICC'S benefit plans, including, without limitation: vacation, disability, life insurance, S.U.B., attendance bonus, pre-retirement leave, optional leave, pension and annuity, accidental death and dismemberment, hospital, surgical, or medical benefits, and the Contractor specifically acknowledges that he/she is not entitled to participate in any of ICC'S plans, including without limitation, those mentioned above.

8b. In recognition of the special nature of the services to be rendered by the Contractor to ICC, the parties specifically agree that the Contractor is an independent contractor and not an employee of ICC. Although the Contractor is an ICC pensioner and is presently eligible for certain plans and programs, this Agreement does not delete from or add to those programs.

9. Contractor shall carry Worker's Compensation, public liability and auto insurance in amounts of \$500,000 for bodily injury and property damage or in amounts satisfactory to ICC.

NOTE: Not required by ICC

NOTWITHSTANDING the foregoing, the Contractor understands that, to the extent required by law, ICC will withhold from his/her compensation appropriate federal and state income taxes and Social Security taxes.


**EITHER party may terminate this agreement at any time for any reason without prior notice.**

**INDIANAPOLIS CASTING CORPORATION**

  
\_\_\_\_\_  
Contractor

308-44-8779  
\_\_\_\_\_  
SS Number

  
\_\_\_\_\_  
Staff Level Manager

  
\_\_\_\_\_  
HR Manager

  
\_\_\_\_\_  
Plant Manager

INTERNATIONAL ENGINE INTELLECTUAL PROPERTY COMPANY, LLC

4201 WINFIELD ROAD, P.O. BOX 1488, WARRENVILLE, IL 60555

T 630 753 5000

D 630 753 3400

Cathi.Majewski@nav-international.com

August 26, 2004

**Via FedEx Overnight**Daniel Davis  
1107 N. Mitthoffer Rd.  
Indianapolis, IN 46299

Re: Submission of Invention No. D5561

Dear Daniel:

Enclosed are copies of the drawings, a specification including claims, and formal papers which comprise a patent application covering your invention submission No. D5561 titled:

**Core Element Fastening And Assembly Method**

Please read very carefully the attached application. If corrections, alterations and/or additions are necessary, note them on a separate sheet of paper and telephone me at 630-753-3400 before signing the formal papers.

Attached to the application is a Declaration form and a Power of Attorney form. Please sign and date these forms in ink at the place indicated. Please sign your name as shown on the form.

The Declaration includes an acknowledgment of your duty to disclose all information that is material to your invention. This duty, which continues throughout the pendency of the patent application, may be discharged by informing me of prior patents, technical papers, competitor's products, etc., that are closely related to your invention.

Also enclosed is an Assignment of this application to International, as well as a set of foreign assignments. The Assignment must be signed before and notarized by a Notary Public. The foreign assignments must be signed before and witnessed by two individuals.

Please return the enclosed documents after you've reviewed and signed them no later than September 7, 2004. I enclose a return FedEx envelope for your convenience in returning these documents. Thank you for your assistance in expediting the signature of these documents.

Very truly yours,


Cathi Majewski  
Administrative Assistant to  
Dennie Kelly Sullivan

Encl.



From: Origin ID: (630)753-3400  
Cathi Majewski  
INTERNATIONAL TRUCK AND ENGINE  
4201 WINFIELD RD  
WARRENVILLE, IL 60555



Ship Date: 26AUG04  
Actual Wgt: 1 LB  
System#: 1404662/INET1850  
Account#: S \*\*\*\*\*

REF: N419 - D5561



Delivery Address Bar Code

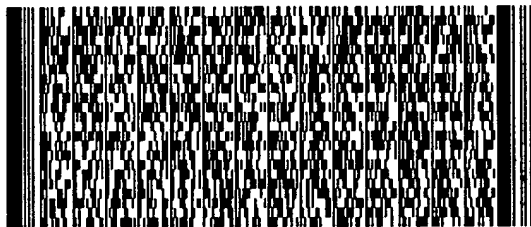
SHIP TO: (000)000-0000

BILL SENDER

**Daniel Davis**

**1107 N. Mitthoffer Rd.**

**Indianapolis, IN 46229**



**STANDARD OVERNIGHT**

**FRI**

Deliver By:  
27AUG04

TRK# **7907 4517 3754**

FORM  
0201

**IND**

**A2**

**46229** -IN-US  
RES

**NR MZZA**



Shipping Label: Your shipment is complete

1. Use the 'Print' feature from your browser to send this page to your laser or inkjet printer.
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From: Origin ID: (000)000-0000  
Daniel Davis

1107 N. Mitthoffer Rd.

Indianapolis, IN 46229



Ship Date: 26AUG04  
Actual Wgt: 1 LB  
System#: 1404662/INET1850  
Account#: S .....

REF: N419 - D5561



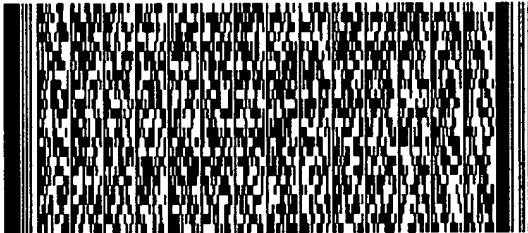
Delivery Address Bar Code

SHIP TO: (630)753-3400

BILL SENDER

**Cathi Majewski**  
**International Truck and Engine Corp**  
**4201 Winfield Rd.**

**Warrenville, IL 60555**



**STANDARD OVERNIGHT**

**FRI**

TRK# 7902 5303 2193

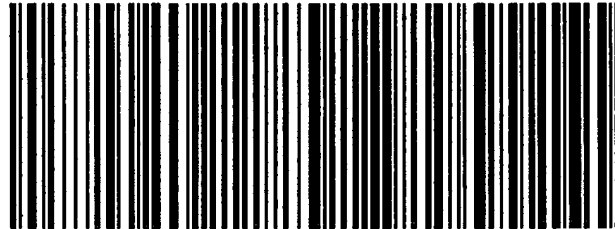
FORM  
0201

Deliver By:  
27AUG04

**ORD A2**

**60555 -IL-US**

**NC GBGA**



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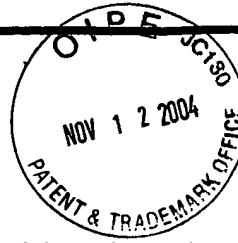
Use of this system constitutes your agreement to the service conditions in the current FedEx Service Guide, available on [fedex.com](http://fedex.com). FedEx will not be responsible for any claim in excess of \$100 per package, whether the result of loss, damage, delay, non-delivery, misdelivery, or misinformation, unless you declare a higher value, pay an additional charge, document your actual loss and file a timely claim. Limitations found in the current FedEx Service Guide apply. Your right to recover from FedEx for any loss, including intrinsic value of the package, loss of sales, income interest, profit, attorney's fees, costs, and other forms of damage whether direct, incidental, consequential, or special is limited to the greater of \$100 or the authorized declared value. Recovery cannot exceed actual documented loss. Maximum for items of extraordinary value is \$500, e.g. jewelry, precious metals, negotiable instruments and other items listed in our Service Guide. Written claims must be filed within strict time limits, see current FedEx Service Guide.



**Majewski, Catherine M (Cathi)**

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**From:** FedEx [donotreply@fedex.com]  
**Sent:** Friday, August 27, 2004 12:18 PM  
**To:** cathi.majewski@nav-international.com  
**Subject:** FedEx shipment 790745173754



Our records indicate that the shipment sent from Cathi Majewski/INTERNATIONAL TRUCK AND E to Daniel Davis has been delivered.  
The package was delivered on 08/27/2004 at 12:15 PM and signed for or released by A.WATSON.

The ship date of the shipment was 08/26/2004.

The tracking number of this shipment was 790745173754.

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To track the status of this shipment online please use the following:  
[http://www.fedex.com/cgi-bin/tracking?tracknumbers=790745173754  
&action=track&language=english&cntry\\_code=us](http://www.fedex.com/cgi-bin/tracking?tracknumbers=790745173754&action=track&language=english&cntry_code=us)

Disclaimer

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent Application of: Watkins et al. )  
Serial No.: 10/849,996 )  
Filed: May 20, 2004 )  
For: Core Element Fastening And Assembly Method )

**DECLARATION OF CATHERINE M. MAJEWSKI**

Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

1. I, Catherine M. Majewski, am the administrative assistant for Dennis Kelly Sullivan, the attorney handling the above-mentioned file.
2. On August 26, 2004, I mailed (via Federal Express, delivery receipt requested) formal paperwork to Daniel Davis, which included a specification, drawings, Declaration, Power of Attorney, Foreign Assignments and Joint Assignment form.
3. After having not received the signed paperwork back from Mr. Davis, I attempted to phone him at his last known phone number (317-985-0866). I reached a recording which indicated the "number was not in service." Also, I received a delivery receipt from Federal Express indicating the package had been delivered on August 27, 2004 and signed for by A. Watson.
4. I then phoned my company's payroll department and was provided with a phone number for Mr. Davis, which is the same number I had attempted to phone earlier (317-985-0866). I made repeated attempts to reach Mr. Davis via this phone number, however, each time I called, I received a recording that stated the number was not in service. I made about 10 attempts to contact Mr. Davis at this phone number over a period of 14 days and all were unsuccessful. I was also told by a co-inventor on this file that he had also tried calling Mr. Davis at the above-mentioned number and he also received the same recording.
5. I had also conducted several people searches for Mr. Davis on the Internet and each attempt was unsuccessful.
6. I declare a diligent effort was made by myself to locate inventor Daniel Davis.

Catherine M. Majewski further declares that all statements made herein of her own knowledge are true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application and patent resulting therefrom.

Declared at Waukegan, IL, this 5<sup>th</sup> day of November, 2004.

Dated: 11/5/04

  
(Signature)

Printed: Catherine M. Majewski